

1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte PETER K. KASSAB
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13 Appeal 2007-0171
14 Application 09/901,472
15 Technology Center 1700
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18 Oral Hearing Held: February 6, 2007
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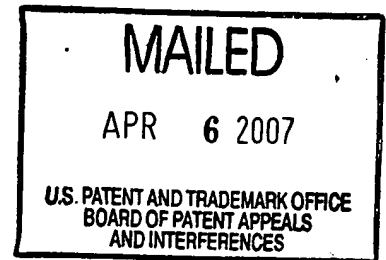
22 Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and
23 CATHERINE Q. TIMM,
24 Administrative Patent Judges
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26 ON BEHALF OF THE APPELLANT:
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36 ALSO PRESENT:

37 PETER KASSAB



1 The above-entitled matter came on for hearing on Tuesday,
2 February 6, 2007, commencing at 9:08 a.m., at The U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah
4 Rinaldo, RPR, Notary Public, CCR No. 0315067.

5 JUDGE GARRIS: Welcome to the board, sir. Once you are
6 settled, please introduce yourself.

7 Sir, as you know, you have about 20 minutes to present your
8 case.

9 MR. NYKAZA: Good morning. May it please the board, my
10 name is Paul Nykaza and I represent the individual inventor in this case,
11 Pete Kassab, who is here with us today.

12 JUDGE GARRIS: Welcome to the board, Mr. Kassab.

13 MR. KASSAB: Thank you.

14 MR. NYKAZA: If I may, I would like to reserve a couple
15 minutes at the end of the argument for Mr. Kassab to just address the
16 trimming limitation in a little more detail, and the trimming limitation is
17 included in all the pending claims before us today.

1 JUDGE GARRIS: Sure. That would be fine.

2 MR. NYKAZA: Thank you. I would like to address two main
3 issues in the argument. The first issue would be the obviousness rejection
4 based on the German patent, Courtney, and the Japanese reference, and then
5 further, in view of the Great Britain reference, the admitted prior art, and the
6 reference to Langen.

7 The second issue I would like to address is the obviousness
8 combination based on Langen in view of Honaker and Yoshida.

9 Now, as a quick background, Mr. Kassab's invention is directed
10 to a vinyl film intermediary that is used with windshield stickers. Especially
11 in Chicago, we have windshield stickers that have a very strong adhesive.
12 And when people put them on their windows, it's very difficult to get them
13 pulled off.

14 And using Mr. Kassab's vinyl film intermediary, using a low-
15 tack adhesive, the intermediary is joined with the high-tech adhesive, the
16 edges of the intermediary are trimmed, and then the low-tack adhesive is
17 then adhered to the windshield.

1 Now, with the first rejection, the main rejection was the
2 German patent, Courtney, and the Japanese reference. And I don't believe
3 that there is the requisite motivation to combine these references, and then in
4 addition, the German patent teaches away from the proposed combination.

5 Now, all of the claims require this trimming element. The
6 claims require that the film is trimmed such that its peripheral edges will be
7 in registry with the windshield sticker.

8 For example, in claim 6, claim 6 requires that the vinyl film is
9 trimmed such that the peripheral edges of the vinyl film is essentially in the
10 registry with the peripheral edges of the window sticker.

11 Now, if I could just focus real quick on the German patent and
12 Courtney, because that's what the examiner is using to combine, to meet this
13 element of the claims.

14 Now, he hasn't been consistent in the application of this
15 rejection. When the examiner first rejected these claims based on these two
16 references, the examiner indicated that the German patent indicates that the
17 film and the sticker should have a matching size and shape.

1 And the German patent just doesn't say that. It does not say
2 that. The German patent is an eight-sentence specification with no figures.

3 And the one statement that is included in the German patent is
4 that the format for the film is selected so that the majority of the stickers and
5 conventional stickers can be used with it.

6 And what that means is that the film in the German patent has
7 to be larger, so that most stickers can be used to it. From there, the reference
8 is silent.

9 And with that statement, that statement teaches away, teaches
10 one away from moving to Courtney, which we can see does show trimming,
11 although there's differences with what Courtney shows and with what is
12 claimed in applicant's invention.

13 Now, the examiner has --

14 JUDGE TIMM: Are you saying, then, that the German
15 reference teaches away because you wouldn't consider, or you wouldn't
16 expect one skilled in the art wouldn't expect it to work if it were the same

17

1 size? Or are you just saying it teaches away because it's silent on that
2 particular point?

3 MR. NYKAZA: It teaches away because it tells you that they
4 want their film larger. They want it larger. They never get to trimming.
5 And because they want it larger, you would never get to looking towards
6 Courtney for trimming.

7 So the fact that they make that statement, there's not a lot in
8 there. Like I said, it's very brief, no figures. There's not a lot in there. But
9 the one statement they make, the one statement they make in this reference
10 is that the format has to be so that most stickers can be used on it. And that
11 means that that film has to be larger. And from there it's silent.

12 And to then start saying, well, the examiner then doesn't in
13 subsequent readings, well -- he does not say any more that it has to be -- you
14 know, that it indicates it has to be the same size and shape.

15 In fact, in his brief, he recognizes that it doesn't. But then he
16 says, well, it should have a shape at least matching. And you know what, it
17 doesn't say that either. It says it has to be larger.

1 The other statement the examiner makes is that, well, the
2 German patent doesn't say it always has to be larger. But that, again, we
3 should focus on what the German patent actually says, not things that could
4 be or speculative things that would require us to kind of prove a negative.

5 Saying that the film doesn't always have to be larger is really
6 trying to say the same thing as before, trying to say, hey, the German patent
7 indicates that these edges should be in registry.

8 JUDGE TIMM: Well, turning to Courtney, doesn't Courtney
9 have a film which you are replacing a sticker on and it is also taught to be
10 larger? And then you are also then trimming that larger film?

11 MR. NYKAZA: Right. That is correct. That is correct.
12 However, with the teaching away statement in the German patent, we never
13 get to Courtney. And then what Courtney becomes is an isolated disclosure.
14 There is differences with Courtney.

15 Courtney is directed to a bumper sticker to be placed on the
16 outside of a vehicle. The present invention is directed to windshield stickers
17 that are placed on the inside of a windshield. Courtney mounts in a different

1 fashion. Courtney says, use Velcro strips. If you don't use Velcro strips, use
2 double-sided tape.

3 So even though Courtney may say, use my mounting aid to put
4 a sticker on other surfaces of the vehicle, it's clear that based on the way they
5 teach the mount, that what they are talking about is other outer surfaces of
6 the vehicle. And that's just another distinction where someone would not
7 look to Courtney to practice the invention as claimed.

8 So with the statement that teaches away in the German patent,
9 again, it's an eight-sentence patent. But the one thing they say is that we
10 want this larger. So you would never get to Courtney. You just never would
11 get there.

12 Now, if I could move real quick to the Japanese reference, the
13 claims require a vinyl film. And applicant came to a vinyl film after
14 considerable testing.

15 The vinyl film in the present application is stiffer, it doesn't
16 fray, it won't start peeling off from the windshield over time because these
17 are usually on at least a year. It is easier to trim because it's stiffer.

1 It -- also the vinyl film better supports a low-tack adhesive,
2 such that the low-tack adhesive does not bind up over time where it would
3 leave a residue on the windshield. Now, all of those points are talked about
4 in our specification.

5 The vinyl film also holds up to the environmental conditions
6 like, you know, if there's high heat over a long period of time. The vinyl
7 film is better suited to meet those conditions.

8 So the applicant did some testing. It wasn't just, well, we'll say
9 vinyl. The applicant did some testing and said, you know, for this particular
10 application, for a low-tack adhesive, a vinyl film is best.

11 Now, what the examiner has done is he has found a patent that
12 is directed to a Japanese reference that is directed to a vinyl sticker. And we
13 don't believe there is a requisite motivation to make this combination.

14 First of all, the German patent is completely silent on, it would
15 be good if we had a stiffer material or even some sort of material that would
16 fall within vinyl. Completely silent. Again, it doesn't say a whole lot in that
17 reference. Courtney is the same way. Courtney is silent on a vinyl film.

1 So he picks out a Japanese reference to say, well, this shows a
2 vinyl film. But the Japanese reference is just a sticker reference. And we're
3 not claiming a vinyl sticker. The sticker material for us is not part of our
4 claim. It's the intermediary, the film intermediary in the claims that's
5 important. And that's what we call out as vinyl.

6 And the Japanese reference does not suggest a vinyl film
7 intermediary. So the examiner has really just kind of broken down the
8 claims and said, well, the German patent, it shows these things. The
9 Courtney shows trimming and, oh, the claim says vinyl film, so this
10 Japanese reference shows vinyl film.

11 And we believe it's just -- he has broken down the claim into its
12 individual parts and put things together without the requisite tie-ins to make
13 that combination proper.

14 I also would like to discuss a couple of the other elements of the
15 claims that we believe, even if you combined references, they don't show
16 certain elements as they are claimed.

17

1 The first is the protective layer. Now, some of the claims
2 require a protective layer along with the vinyl film. And the vinyl film is
3 trimmed, along with the protective layer, to be in registry with the sticker.

4 In the German patent, completely -- well, the German patent
5 and Courtney do not teach this. In Courtney, Courtney doesn't even use a
6 protective layer. In Courtney, because of the way they teach to mount the
7 sticker using Velcro strips or double-sided tape, they don't need a protective
8 layer; and therefore, you would never trim a protective layer.

9 And it's a useful part of applicant's invention, because, besides
10 for the vinyl film being stiffer, the protective layer also adds additional
11 rigidity when you are trimming and when you are getting ready to mount the
12 assembly to the windshield.

13 So none of those references show trimming a vinyl film
14 intermediary and a protective layer. Now, at times when the examiner will
15 say, well, the Great Britain patent shows a protective layer.

16 Again, now not only do we have three references that are
17 attempted to be combined, now we have a fourth reference. I still do not

1 believe that there is some point in the references that would point someone
2 in there to go look to the Great Britain patent to say, well, there's a
3 protective layer and I'm going to start trimming the protective layer.

4 As I said, in Courtney, the most relevant reference to trimming
5 doesn't use a protective layer. So you would never get to the point where
6 you are trimming both the vinyl film intermediary and the protective layer.

7 JUDGE TIMM: Do they trim the protective layer in the Great
8 Britain application?

9 MR. NYKAZA: They don't trim as it's claimed in our claims,
10 because in our claims, we trim the film and the protective layer so that they
11 are in registry with a presized sticker.

12 And what they do in Great Britain is, when they do mention
13 trying to fit an entire windshield -- the Great Britain patent is kind of used
14 car lots where they have a big price on a car window.

15 And they just talk about slicing the entire assembly, the entire
16 assembly across to fit a windshield. So they are not trimming a substrate or
17 a vinyl film and a protective layer to be in registry with the sticker.

1 JUDGE TIMM: But they are trimming?

2 MR. NYKAZA: They are trimming.

3 JUDGE TIMM: With the protective layer on the assembly.

4 MR. NYKAZA: Right. They trim the entire assembly. And
5 that's different from our claims. Because, again, our claims specify we trim
6 to coincide with the edges of the sticker.

7 JUDGE TIMM: Are we considering claim 6 at this point?
8 Because that claim is directed to the sticker assembly itself, not the process
9 of making it.

10 MR. NYKAZA: Right. Because this claim still calls out
11 trimming. So the structural distinction is that the protective layer and the
12 vinyl film still has that trimmed edge. But it's trimmed according to the
13 edges of the sticker. The sticker is not trimmed, whereas in Great Britain,
14 everything is trimmed.

15 JUDGE TIMM: So do you think there is a structural distinction
16 between trimming only the vinyl film and the low-tack adhesive portion,
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1 rather than trimming the whole thing? What would be the structural
2 distinction between those two assemblies?

3 MR. NYKAZA: Well, the structural distinction is that, in one,
4 everything has a trimmed edge. And in the other, in the claimed, only a
5 portion has the trimmed edge. And it's important because of how we get
6 there.

7 In Great Britain, they are making an entire substrate and then
8 trimming the whole thing. And in applicant's invention is not showing how
9 to make a sticker. His invention is using this vinyl intermediary to be used
10 with a preexisting sticker.

11 So the distinction is in the fact that in one you have a complete
12 cut through the substrate, the entire substrate. And in the other, you just trim
13 the film intermediary and the protective layer.

14 Now, I would also like to point out that some of the claims call
15 out strips of vinyl film as the intermediary. In an alternative embodiment,
16 certain window stickers, instead of having a complete adhesive over the
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1 entire sticker, they have temporary stickers that have thin strips of adhesive
2 on each side of the sticker.

3 And some of the claims are directed to this scenario where the
4 vinyl film intermediary in these claims would be trimmed so that they would
5 coincide with the strips of adhesive. And, again, the German patent,
6 completely silent on having strips of vinyl film, strips of adhesive for that
7 matter.

8 Courtney does not talk about having strips of a mounting aid.
9 Again, they use a different mounting structure, so there wouldn't be that
10 suggestion.

11 What the examiner does is then refer to a couple other
12 references. Now to combine, I think, five references now. He refers to the
13 admitted prior art in our application, which all that is, is a description of the
14 sticker, the temporary sticker itself. It never talks about the vinyl film. That
15 vinyl film is actually part of the invention.

16 So the admitted prior art, in our application, is merely a
17 description of the sticker with the thin strips of adhesive.

1 Then he calls out the Langen reference. But again, there hasn't
2 been a showing of how one skilled in the art would be directed to each one
3 of these references down the road.

4 Plus, in Langen, Langen still does not show trim strips of vinyl
5 film. Langen shows double-sided tape. And the reason for that is that in --
6 Langen is not a patent about intermediaries.

7 Langen is a patent that shows how to make a sticker. And in
8 making that sticker, they say, let's use double-sided tape. And because of
9 that, it's already presized, so there's no need to trim strips of film.

10 And in these particular claims, not only do we have strips of
11 film, but the strips are trimmed to coincide with the strips of adhesive. And
12 even if you combined all the references that the examiner has cited, you still
13 won't have the result of strips after adhesive that are trimmed to coincide --
14 I'm sorry, strips of film that are trimmed to coincide with the strips of
15 adhesive.

16 And I would point out we have a claim allowed in the
17 application directed to something similar, but calls out static cling film strips

1 instead of vinyl film strips.

2 And the reasons for allowance for that are equally applicable to
3 these claims. The reasons for allowance for that, you know, called out, yes,
4 the prior art does not show static cling film strips that are trimmed, because
5 all of these references do not show that.

6 Now, I submit to you that the reasons for allowance were not
7 solely on the static cling film material, because they recognize that those
8 other references, any other references in the cited art, don't show strips of
9 trimmed film. So those reasons for allowance are equally applicable to the
10 strip claims in this application.

11 I would like to move now to the Langen rejection. The
12 examiner cited Langen in view of Honaker and Yoshida in rejecting claims
13 1, 14 and 22.

14 The examiner pointed to the Langen reference in its reference to
15 when they say make double-sided tape to label stock. And in view of the
16 term "label stock," said, well, here is Honaker and Yoshida that says make
17 label stock out of vinyl, if you please.

1 That doesn't rise to the requisite level of teaching applicant's
2 invention. You know, a one-word reference about label stock.

3 Plus, we're not claiming a double-sided tape or label stock or
4 anything like that. Our claims are directed to an intermediary. And so
5 perhaps it is a teaching that if one wanted to use some sort of double-sided
6 tape, they could use some that are with vinyl. But that's not a teaching of
7 applicant's invention.

8 Plus, in these claims, claims 1, 14 and 22, there still is the
9 limitation that the vinyl film is trim. And in Langen, that structure is not
10 shown. So there is a difference between -- a structural difference between
11 what is claimed in 1, 14 and 22, and what is shown in Langen.

12 Because in Langen, because they use double-sided tape, it's a
13 presized tape; there's no need to trim. The examiner will refer to what
14 Langen calls out as slitting and bursting. And that still doesn't show that you
15 have trimmed vinyl film as it's claimed in 1, 14 and 22.

16 The slitting aspect of Langen is removing what they call the
17 tractor feed portions of this particular label. And when they slit, they don't

1 even touch the double-sided tape.

2 When they burst, what they are talking about in bursting is they
3 are just removing each label. They are separating each label. And they are
4 still not trimming a vinyl film to coincide with a preexisting sticker.

5 So I believe that there still is a structural distinction between
6 what is claimed in 1, 14 and 22, and the structure that is shown in Langen.

7 JUDGE GARRIS: So would you care to go ahead and finish
8 your presentation.

9 MR. NYKAZA: Sure, if I can, if I could have just a couple
10 quick minutes for Pete Kassab, the inventor, to say a little bit more about the
11 trimming, if I may, just from his experience of how it's not so obvious to
12 trim this film.

13 JUDGE GARRIS: Mr. Kassab, that would be fine for a minute
14 or two. Please give us your thoughts on this matter.

15 MR. KASSAB: Thank you for your time. I'll be very brief and
16 obviously speak in layman's terms, so please forgive me.

17

1 I have been working on this for almost ten years now, in some
2 way, shape or form. It's been on the market in various forms. I sell it
3 through a number of, you know, Brick and Mortars, Ace, Canards,
4 Walgreens.

5 I see my product on the street all the time. I run into people all
6 the time. I receive all the e-mails and people have questions about the
7 product.

8 And again, in layman's terms, it occurred to me during my
9 testing period, and it occurred to me as I've seen the product in the
10 marketplace, both with consumer and with professionals, that it's not
11 obvious to assume that you would trim my material to coincide with the
12 peripheral edge of the sticker that you are starting with.

13 It's evident from a consumer standpoint, I'll walk down the
14 street in Chicago or New York or Virginia where these stickers are all over
15 the place, and I'll see my product being used. And the only reason I can see
16 it being used is because they are misapplying it. They are not trimming it
17

1 around the peripheral edge. And I'll see the border of my intermediary film
2 sticking out.

3 And so I see it on the street all the time and I'll think, Well, they
4 didn't read the directions or they just didn't assume it properly. So that's on
5 the consumer end.

6 On the professional end, this is a catalog that goes out
7 nationally, Solutions catalog; they have a lot of solution products in here, of
8 which they have a lot of automotive products as well. And I was featured in
9 here a while back.

10 And despite me submitting a proposal and getting in the catalog
11 and official specs and providing the directions and product samples, the
12 people who put together the catalog still -- if you want I can bring this up to
13 you as well -- put the product in the catalog demonstrating how it works and
14 failing to trim around the peripheral edge of the sticker.

15 So here are people who are experts in marketing different
16 products and they didn't even assume that, despite being provided all the
17 specs and directions.

1 So I know it's one of those things that you might think -- I
2 might even think, Oh, that's a natural assumption, but it hasn't proven to be.
3 That's all I wanted to point out. And I thank you for your time.

4 JUDGE GARRIS: Mr. Kassab, why do you instruct users of
5 your product to trim?

6 MR. KASSAB: Well, I think what happens is -- and another
7 way that I can show that people don't assume it, is to say, well, if I use your
8 intermediary with my registration sticker, then someone is going to steal my
9 sticker because it comes right off the windshield.

10 And I'll say, Well, no, you won't have it stolen because they
11 won't know it's on there.

12 And they'll say, Well, how come?

13 I'll say, Well, if you trim the material around the peripheral
14 edge of your provided registration sticker, it becomes invisible. It's optically
15 clear. It's right on the surface of your sticker, so your sticker appears to be
16 stuck right against the windshield as if you just stuck it up there.

17

1 My product is optically clear, then thus becomes virtually
2 invisible and is stuck between the two and so you can't see it.

3 Once I kind of give them that thought, and then just discuss the
4 actual application process, which I brought a lot of materials and samples, I
5 basically can walk through step-by-step on how you apply my product to the
6 sticker and trim around the peripheral edge, and you are actually trimming
7 around the peripheral edge of the sticker before you take my backing paper
8 off.

9 So what seems like a very simple product has proven, in the
10 marketplace and with professionals, to not be so simple, and not having
11 assumptions, because you are kind of doing everything backwards.

12 You start with your sticker, you put it on the film, the backing
13 paper is on it, and then you trim it off, and you don't even see your actual
14 front of your registration sticker until the very last step when you peel that
15 backing protective paper off and put it in your window. And so I hope I
16 answered your question.

17

1 JUDGE GARRIS: You did. Thank you.

2 MR. NYKAZA: The other aspect is with the trimming, they
3 are allowed to put more -- we talk about this in the application -- but you are
4 able to put more stickers within a smaller area to cut down on kind of
5 encroaching into one's viewpoint and so forth.

6 We thank you for your time and just in conclusion, the Great
7 Britain patent, just, there is not a whole lot there in eight sentences -- the
8 German patent. And the one sentence in there actually teaches away from
9 the proposed combination with Courtney. It would direct someone away
10 from going to Courtney to trim. So we appreciate your time today. Thank
11 you.

12 JUDGE TIMM: One last question. Do you have a copy of that
13 catalog in the record?

14 MR. NYKAZA: We have -- he talks about it in the declaration
15 that he submitted in the record.

16 JUDGE TIMM: But there is not an actual copy?

17

1 MR. NYKAZA: I don't think we have a copy of that particular
2 one. We talk about it in the declaration. We could submit it if you think that
3 would be appropriate.

4 JUDGE TIMM: I was just curious.

5 JUDGE GARRIS: I think we understand the point that was
6 being made. It's in the declaration.

7 MR. NYKAZA: Yes, in the declaration he talks about it.
8 Another thing that he talked about here today is consistent with his
9 declaration.

10 JUDGE GARRIS: Thank you both.

11 MR. NYKAZA: Thank you for your time.

12 JUDGE GARRIS: Thank you for helping us with this case.
13 We appreciate it.

14 (Whereupon, the proceedings at 9:38 a.m. were concluded.)
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